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10/711,650

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Calvin Charles Shaw

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CALVIN CHARLES SHAW

Appeal 2009-001082
Application 10/711,650
Technology Center 3600

Decided:¹ May 29, 2009

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
KEN B. BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Calvin Charles Shaw (Appellant) seeks our review under 35 U.S.C. § 134 from a final rejection of claims 1 through 20. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

Appellant's claimed invention pertains to an apparatus and method for framing a work. (Spec. 1, [Para 1].) According to the Appellant, the claimed subject matter is particularly suited to the framing of greeting cards. (*Id.*) Claims 1 and 11, reproduced below, are representative of the subject matter on appeal.

1. A method of framing a work, comprising:
threading the work through a plurality of slits in a sheet of material, wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits;
positioning the sheet of material within a picture frame;
and
attaching a backing behind the sheet of material.
11. An apparatus for framing a work, comprising:
a picture frame;
a first mat, wherein the first mat contains an opening that is sized to allow the work to be viewed through the opening;
a second mat, wherein the second mat contains a plurality of slits that are sized and positioned to allow the work to be held into place upon the second mat by threading the work

through the slits, wherein an entire length of an edge of the work is threaded through at least one of the plurality of slits; and

a mount board that is positioned relative to the picture frame, first mat, and second mat so as to enclose the first mat and second mat between the picture frame and mount board.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Anthony	US 4,391,053	July 5, 1983
Ristuccia	US 4,849,056	July 18, 1989
Plumly	US 5,524,373	June 11, 1996

The following Examiner's rejections are before us for review:

1. Claims 1-3 and 9-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anthony and Ristuccia; and
2. Claims 4-8 and 13-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anthony, Ristuccia, and Plumly.

ISSUES

The first issue presented in this appeal pertains to the obviousness rejection based on Anthony and Ristuccia. Claims 1 and 11 refer to slits in a sheet or mat through which the work is threaded. An entire length of an edge of the work is threaded through at least one slit. Appellant contends that the Examiner has failed to set forth a proper motivation to combine Anthony and Ristuccia so as to arrive at the claimed subject matter having such slits. (Second Amended Appellant's Brief filed June 26, 2007 (App. Br.) 4.) The Examiner responds that Ristuccia's vertical slot configuration

would provide a more secure holding means for the framed work than would Anthony's diagonal slits located only at two opposing corners, thus providing a motivation to combine the references. (*See* Ans. 4.) The Examiner also concluded that Appellant's claimed subject matter would have been obvious as the substitution of one known element for another to yield predictable results. (*Id.*) Therefore, the first issue on appeal is:

Has the Appellant shown that the Examiner failed to set forth a rational reason why one of ordinary skill in the art would have combined Anthony and Ristuccia to arrive at the claimed subject matter?

Regarding claims 8 and 18, the Appellant argues that the Examiner erred in rejecting the claims as obvious because "none of the three cited references contains any teaching or suggestion relating to the use of detachable attachment surfaces or magnetic surfaces to attach an envelope associated with a framed work." (App. Br. 6.) The Examiner did not find that any cited reference discloses an envelope. (*See* Ans. 3-4, 5) Rather, the Examiner concluded that the recitation of an envelope in dependent claim 8 does not further limit the method of the claim from which it depends, and that, in apparatus claim 18, an envelope is not recited as a claimed structure. (*Id.* at 5.) In light of these contentions, the issues presented include:

Does the recitation of an envelope limit the scope of the method of claim 8, and is an envelope a required structural element of the apparatus of claim 18?

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence.

1. Anthony discloses a picture frame assembly adapted to be secured to the sun visor of an automobile, or, alternatively, hung on a wall or stood on a flat surface such as a table. (Anthony, col. 1, ll. 5-9.) Anthony also teaches a backing plate 40 containing slits 80-91 into which the corners of pictures or photographs may be placed. (*Id.*, col. 4, ll. 44-46.) Anthony's Figure 9 depicts the backing plate as having two diagonal slits for each item to be framed, with the slits located at opposing corners of the item. (*Id.*, fig. 9; *see also* App. Br. 4.)

2. The Examiner found that Anthony discloses all of the limitations of claim 11, except that Anthony does not disclose slits configured such that an entire length of one edge of the work may be threaded through at least one of the slits. (Ans. 3.) The Appellant does not contest these findings. (*See* App. Br. 3-4.)

3. Ristuccia discloses an index card for a rotary file, with the index card configured to hold a business card. (Ristuccia, col. 1, ll. 5-8; figs. 2, 5A-5D.) Ristuccia teaches the use of vertical slots 50 and 52 through which the ends of the business card are threaded. (*Id.*, col. 3, ll. 48-59; figs. 5A-5D; *see also* App. Br. 4.)

4. Plumly discloses an advertisement apparatus used in a cavity formed in the floor of a building. (Plumly, col. 1, ll. 45-46.) Plumly's apparatus comprises several layers, including a magnetic material layer 31M which constitutes a frame having a central opening 31(O) into which an advertising layer fits. (*Id.*, col. 5, ll. 2-12; fig. 6.) A metal layer 37 is removably secured by magnetic attraction to the magnetic layer 31M. (*Id.*, col. 5, ll. 23-30.)

5. Plumly's magnetic layer 31M and the metal layer 37 are surfaces adapted to allow the attachment thereto of, for example, a magnetic patch which is adapted to be affixed to an item such as an envelope.

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007) (quoting 35 U.S.C. § 103). In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 415, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Court pointed out that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss* [*v. Greenwood*], 11 How. 248 [(1851)]." *KSR Int'l Co.*, 550 U.S. at 415 (citing *Graham*, 383 U.S. 1, 12 (1966)). The Court noted that "when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *Id.* at 416 (citing *United States v. Adams*, 383 U.S. 39, 50-51 (1966)). The Court explained:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary

skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

ANALYSIS

The Rejection of Claims 1-3 and 9-12 under 35 U.S.C. § 103(a) as being Unpatentable over Anthony and Ristuccia

Appellant argues claims 1 and 11 as a group. (App. Br. 3.) We select apparatus claim 11 as the representative claim, and method claim 1 stands or falls with claim 11. 37 C.F.R. § 41.37(c)(1)(vii) (2008).

Appellant does not contest the Examiner’s findings that Anthony discloses all of the limitations of claim 11 with the exception of a slit through which an entire edge of the work may be threaded. (Fact 2.) Anthony’s apparatus has two diagonal slits for holding opposing corners of the item to be framed. (Fact 1.) Ristuccia teaches the use of vertical slots for holding the ends of a business card. (Fact 3.) To replace Anthony’s diagonal slits with Ristuccia’s vertical slots, so as to allow an entire edge of a work to be threaded through a slit, would have been prima facie obvious as a simple substitution of one known element for another to obtain predictable results.

Appellant argues that the Examiner’s initially proposed motivation to combine the references is improper. (App. Br. 4.) This argument is foreclosed by *KSR*, in which the Court rejected the rigid requirement of a teaching, suggestion or motivation to combine known elements in order to

show obviousness. *KSR Int'l Co.*, 550 U.S. at 418-19. Further, we are not persuaded by Appellant's argument that vertical slots would be unacceptable for use in Anthony's vehicle-mounted picture frame embodiment (App. Br. 4). In addition, even if vertical slots are undesirable in moving vehicle applications, as Appellant suggests, that fact does not indicate that it would not have been obvious to use such slots in Anthony's alternative wall mounted and tabletop applications (Fact 1).

Appellant also argues that Anthony and Ristuccia are not directed to the problem addressed by Appellant. (App. Br. 4.) This argument is unavailing as "neither the particular motivation nor the avowed purpose of the [Appellant] controls" in an obviousness analysis. *KSR Int'l Co.*, 550 U.S. at 419.

For the foregoing reasons, we conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1 and 11 as obvious over Anthony and Ristuccia.

Appellant does not present additional arguments concerning claims 2-3, 9-10, and 12, which depend from either claim 1 or claim 11. (App. Br. 4.) Rather, Appellant asserts that those dependent claims are patentable for the reasons previously given for the independent claims 1 and 11. (*Id.*) Because Appellant has not shown that the Examiner erred in rejecting claims 1 and 11 as unpatentable over Anthony and Ristuccia, Appellant has also failed to show that the Examiner erred in rejecting dependent claims 2-3, 9-10, and 12 over those references.

The Rejection of Claims 4-8 and 13-20 under 35 U.S.C. § 103(a) as being Unpatentable over Anthony, Ristuccia, and Plumly

Claim 8

Method claim 8 depends from claim 7. Claim 7 (which depends indirectly from claim 1) recites the step of “attaching a magnetic surface to an item associated with the work; and magnetically affixing the item to the sheet of material.” Claim 8 recites that “the item is an envelope.” We disagree with the Examiner’s conclusion that the recitation in claim 8 of an envelope does not further limit the claimed method (Ans. 5). Claim 8 does not, as the Examiner suggests, merely require magnetically attaching a layer to something else (*id.* at 3-4, 5). Rather, claim 8 requires the performance of the acts of attaching a magnetic surface to an envelope, and affixing the envelope to the sheet. The Examiner did not find that any cited reference discloses such acts involving an envelope. (*See id.*) As such, we cannot sustain the rejection of claim 8.

Claim 18

Claim 18 is an apparatus claim that depends from claim 16. Claim 16 (which depends from independent claim 11) recites:

the first mat, the second mat, or the mount board includes a first detachable attachment surface adapted to allow the first detachable attachment surface to attach to a second detachable attachment surface that is adapted to be affixed to an item associated with the work.

Claim 18 recites that “the item is an envelope.” We disagree with the Appellant’s argument that the recitation of an envelope serves to patentably distinguish claim 18 over the prior art (App. Br. 5-6). The apparatus defined by claim 18 does not require an envelope to be part of the claimed structure. Rather, claim 18 requires structure in the form of a first detachable

attachment surface, which is merely adapted to attach to a second detachable attachment surface, which, in turn, is adapted to be affixed to an envelope. Appellant's Specification indicates that a surface (i.e. the recited "first detachable attachment surface") is adapted to be affixed to an envelope when the surface is magnetically attracted to a self-adhesive magnetic patch (i.e. "a second detachable attachment surface") that may be attached to an envelope. (Spec. 5-6, [Para 24].) Plumly discloses a frame for an in-floor advertisement that includes a magnetic layer removably secured to a metal layer. (Fact 4.) Both Plumly's magnetic layer and metal layer are surfaces adapted to be attached to a magnetic surface that, in turn, is adapted to be affixed to an item such as the envelope. (Fact 5.) Accordingly, Appellant has not persuaded us of error in the Examiner's conclusion that the cited references render the structure of claim 18 obvious.

Claims 4-7, 13-17, and 19-20

Claims 4-7, 13-17, and 19-20 depend directly or indirectly from either claim 1 or claim 11. Appellant appears to assert that these claims are patentable over Anthony and Ristuccia for the same reasons previously given for claims 1 and 11, and contends that Plumly does not cure the deficiencies of Anthony and Ristuccia with respect to claims 1 and 11. (App. Br. 6.) As discussed *supra*, we have concluded that the Appellant has not shown that the Examiner erred in rejecting claims 1 and 11 as obvious over Anthony and Ristuccia. Therefore, there are no deficiencies in that regard for Plumly to cure. Accordingly, Appellant has not shown that the Examiner erred in rejecting claims 4-7, 13-17, and 19-20 as obvious over Anthony, Ristuccia, and Plumly.

CONCLUSIONS

We conclude that the Appellant has not shown that the Examiner failed to set forth a rational reason why one of ordinary skill in the art would have combined Anthony and Ristuccia. Therefore, the Appellant has failed to show that the Examiner erred in rejecting claims 1-3 and 9-12 as obvious over Anthony and Ristuccia, and in rejecting claims 4-7, 13-17, and 19-20 as obvious over Anthony, Ristuccia, and Plumly.

We also conclude that an envelope is not a required structural element of the apparatus of claim 18. Therefore, the Appellant has failed to show that the Examiner erred in rejecting claim 18 as obvious over Anthony, Ristuccia, and Plumly.

However, we conclude that the recitation of an envelope in claim 8 limits the scope of the claimed method. Therefore, the Appellant has shown that the Examiner erred in rejecting claim 8 as obvious over Anthony, Ristuccia, and Plumly.

DECISION

The decision of the Examiner to reject claim 8 is reversed. The decision of the Examiner to reject claims 1-7 and 9-20 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART

Appeal 2009-001082
Application 10/711,650

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